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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Reinhold BURR et al.

Title: AIR INLET, IN PARTICULAR FOR A MOTOR VEHICLE

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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Sir:

In accordance with the New Pre-Appeal Brief Conference Pilot Program, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

**REMARKS**

Rejection of claims 15-27 based on Kinmartin

Claims 15-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,101,883 ("Kinmartin"). This rejection is traversed for at least the following reasons.

Claim 15 recites "an air-guiding device comprising a plurality of subducts for dividing air in the air-guiding device, and an outflow region with an outer circumferential region and a middle region and, wherein one subduct leads to the middle region and another subduct leads to the outer circumferential region." Kinmartin does not teach or suggest these features because Kinmartin does not teach or suggest any single outflow region with an outer

circumferential region and a middle region. The PTO asserts that the defroster discharge vents 46a and 46b is considered to be the “outer circumferential region” while the vertical passage 58 is considered to be the “middle region.” However, the vents 46a, 46b and the vertical passage 58 are two completely different vents. The vents 45a, 46b and passage 58 are not even in the same outflow region, and the vents 46a, 46b do not at least partially surround the passage 58, which is connoted by the term “circumferential” which describes the outer region. Indeed, the vents 46a, 46b are not said to partially surround any region in an outflow region. Because the vents 46a, 46b are not a circumferential region of an outflow region partially surrounding the passage 58, Kinmartin does not teach or suggest “an outflow region with an outer circumferential region and a middle region and, wherein one subduct leads to the middle region and another subduct leads to the outer circumferential region.” Accordingly, Kinmartin does not teach or suggest all the features of claim 15 and its dependent claims.

For at least this reasons, favorable reconsideration of the rejection is respectfully requested.

*Rejection of claims 28-37 based on Kinmartin and Kamiya*

Claims 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinmartin in view of U.S. Patent 6,575,701 (“Kamiya”). This rejection is traversed for at least the following reasons.

Claim 28 recites “wherein one subduct has a coiled or elongated, helical region” while claim 33 recites “wherein one of the subducts is configured to impart a spot action to the air at an exit of the air duct and another of the subducts is configured to impart a swirl to the air at the exit of the air duct.” The PTO contends that Kamiya teaches these features and “it would have been obvious...to have modified the air inlet of Kinmartin in view of the teaching of Kamiya in order to blow air within a vehicle passenger compartment in particular for an air heater arrangement faster and more efficient airflow.” (Pages 5-6 of the Office Action.) This rejection is improper because there is no reason to combine the teachings of Kinmartin and Kamiya.

The Supreme Court in the *KSR Int'l Co. v. Teleflex, Inc.*,” 127 S.Ct. 1727 (U.S. 2007), recently clarified the standards for obviousness. For example, the Court has stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each

of its elements was, independently, known in the art...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR* at 1741. In addition, the Court in *KSR* stated that a reason to combine elements should be made explicit. *Id.* at 1740-41.<sup>1</sup> Indeed, the Court approvingly cited *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), for requiring an articulated reason. *Id.* at 1741.<sup>2</sup>

In this present case, Kinmartin relates to a distribution duct separated into channels while the passages of Kamiya referenced by the PTO relate to blowers, and not distribution ducts. The distribution duct of Kinmartin and the blower casing of Kamiya have totally different functions and design considerations, and as a result, one with ordinary skill in the art would not have a reason for making the proposed combination. Furthermore, because the distribution duct of Kinmartin and the blower casing of Kamiya have different functions, each of the elements of Kinmartin and Kamiya when combined as proposed by the PTO would not perform the same function as it does in the prior art, a situation quite different from *Ex parte Smith*, Board of Patent Appeals and Interferences (decided June 25, 2007) (precedential decision). In *Smith*, a rejection based on obviousness was upheld because the elements that were combined from various references did not change in their respective functions,<sup>3</sup> which is not the case here. In particular, the spiral side of Kamiya is not acting as an aid to channel air out of the blower (as in Kamiya) but is functioning as an air distributor into the vehicle compartment. Because the PTO's proposed combination would change the function of the spiral side of Kamiya, there is no reason to combine the spiral side of Kamiya with the teachings of Kinmartin. Accordingly, any rejection based on Kinmartin and Kamiya is

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<sup>1</sup> "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." *Id.* at 1740-41.

<sup>2</sup> "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *Id.* at 1741.

<sup>3</sup> "[E]ach of the elements of Wyant, Dick, and Ruebens combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results." *Ex Parte Smith* at 22.

improper, and claims 28 and 33 and their respective dependent claims are not rendered unpatentable over the prior art.

Additionally, any combination of Kinmartin and Kamiya does not teach or suggest all the features of claim 33, particularly the features of "wherein one of the subducts is configured to impart a spot action to the air at an exit of the air duct and another of the subducts is configured to impart a swirl to the air at the exit of the air duct." The passage of Kamiya relied upon by the PTO merely teaches the use of "the side...opposite to a suction portion is enlarged in a spiral fashion." (Column 1, lines 29-35 of Kamiya.) There is nothing to suggest in Kinmartin, Kamiya, or any combination thereof of an exit of an air duct with a subduct that imparts spot action and a subduct that imparts a swirl. As best, Kamiya merely teaches of replacement of the ducts that imparts spot action with the duct that imparts a swirl. Because Kamiya does not teach or suggest an exit of an air duct with a subduct that imparts spot action and a subduct that imparts a swirl, no combination of Kinmartin and Kamiya teaches or suggests all the features of claim 33 and its dependent claims. Accordingly, claim 33 and its dependent claims are not rendered unpatentable over the prior art for this additional reason.

For at least this reasons, favorable reconsideration of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

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